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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,286	07/25/2006	Kiyoung Kim	105-06	6943
23713 7590 04/29/2008 GREENLEE WINNER AND SULLIVAN P C 4875 PEARL EAST CIRCLE SUITE 200 BOULDER, CO 80301				
EXAMINER DAVIS, DEBORAH A				
ART UNIT		PAPER NUMBER		
1655				
MAIL DATE		DELIVERY MODE		
04/29/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/587,286

**Applicant(s)**

KIM, KIYOUNG

**Examiner**

DEBORAH A. DAVIS

**Art Unit**

1655

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3, 4, 7, 8, 11, 12, 15 and 16 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6, 9, 10, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-083)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-16 are under consideration for examination on the merits.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Jeong-Yong et al, (Korean J. Food Science Technology, 2000, Vol. 32, No. 6, page 1403)

An antioxidative composition comprising Hovenia dulcis Thunb extract as an effective ingredient is apparently claimed.

The reference of Jeong-Yong et al, anticipates the claims by disclosing a methanol extract from Hovenia dulcis Thunb as an active ingredient that provides antioxidative and antimicrobial activity (see entire abstract). Please note, since the cited composition appears to be the same as instantly claimed, the claimed functional effects of antifibrosis would be inherent to the instant composition.

Therefore, the reference is deemed to anticipate the instant claims.

Claims 2, 6, 10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuk Hyun Shin (KR 214801).

The claims are drawn to a compositions comprising *Lindera obtusiloba* extract as an effective ingredient.

The reference of Shin anticipates the claims by disclosing a composition comprising extracts from the stem of *Lindera obtusiloba* and preparations thereof (see entire abstract). Please note, since the cited composition appears to be the same as instantly claimed, the antioxidative, antifibrosis, liver and kidney functional effects would be inherent to the cited composition.

Therefore, the reference is deemed to anticipate the instant claims.

Claims 9 and 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Hase et al, (Biol Pharm Bull., April 1997; Vol, 20(4), page 381).

The reference of Hase et al anticipates the instant claims by disclosing an a methanol extract comprising the fruits of *Hovenia dulcis* Thunb which provided hepatoprotective effects in mice and significantly protected against CC14-toxicity in primary cultured rat hepatocytes (see entire abstract). Please note, since the cited composition appears to be the same as instantly claimed, the claimed kidney improving functional effects would be inherent to the instant composition.

Therefore, the reference is deemed to anticipate the instant claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4, 7-8, 11-12 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuk Hyun Shin (KR 214801) in view of Jeong-Yong et al, (Korean J. Food Science Technology, 2000, Vol. 32, No 6, page 1403).

The claims are drawn to a composition comprising *Lindera obtusiloba* ingredient and *Hovenia dulcis* Thunb extracts as active ingredients.

The reference of Shin beneficially teaches a composition comprising extracts from the stem of *Lindera obtusiloba* and preparations thereof providing excellent antibacterial (i.e. antimicrobial) effects (see entire abstract).

The reference of Jeong-Yong et al, beneficially teaches a methanol extract from *Hovenia dulcis* Thunb as an active ingredient that provides antioxidative and antimicrobial activity (see entire abstract).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the instant ingredients for their known benefit (i.e., to antimicrobial, antioxidant properties) since each is well known in the art for the same purpose and for the following reasons. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the instant ingredients for their known benefit since each is well known in the art for the

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same purpose (e.g., having antimicrobial, antioxidant properties) and for the following reasons. It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In re Sussman, 1943 C.D. 518; In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). This rejection is based on the well established proposition of patent law that no invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. The result-effective adjustment of particular working conditions (e.g. determining suitable ratios of such extracts therein) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBORAH A. DAVIS whose telephone number is (571)272-0818. The examiner can normally be reached on 8-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Deborah A. Davis  
Patent Examiner  
Art Unit 1655  
April 2008

/Christopher R. Tate/  
Primary Examiner, Art Unit 1655

